UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/289,168	04/09/99	SAIDA	K 4041J000216

EXAMINER

0M02/0306

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ART UNIT	PAPER NUMBER
3743	7

DATE MAILED: 03/06/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 12-13-99.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

– SEE OFFICE ACTION ON THE FOLLOWING PAGES –

Approval to legend Figs. 6A and 6B as prior art is granted.

Applicants have stated USP 5,755,107 is equivalent to JP-A-123,748. In view of this fact, a copy of it (JA '748) is no longer required.

Applicants have asked the examiner to consider prior art JA 10-244820 relative to the claims here. This reference is so pertinent to this examination as to have translation required. Please provide a translation of this reference in response to this action. This should present no financial hardship to applicants and/or to their assignee.

In order to perfect priority where an intervening reference has been applied in a rejection (in this case JA 10-244820), it is necessary to ascertain that PCT JP 98/03586 does in fact contain a disclosure corresponding to the current one. The Examiner does not read Japanese. In this case MPEP 1895.01 (page 1800-125, col. 1, penultimate paragraph) authorizes requiring a copy of the international application and a translation thereof. Applicants have already provided WO99/07568 which appears to be the published version of PCT JP 98/03586, however no translation has been provided and the examiner would prefer to have a copy of the original international application (not the published version which may differ). The Examiner further notes (with some curiosity) that JA 09-216539 (the earlier Japanese priority document underlying applicants' priority claim under 35 USC 119 in the declaration) does NOT appear to disclose the claimed subject matter here. A review of the drawing figures in that document shows little, if any, overlap with the current drawings. The drawings there appear to show some improved drain means for the evaporator, but no disclosure of the "sideways" introduction of air into the plenum

below the evaporator. In order to expedite examination and to determine the exact priority date to which applicants are entitled, a translation of JA 09-216539 is also required, if applicants persist in claiming benefit of priority under 35 USC 119. See MPEP 201.13-201.14.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirota '107 or Ito '368 in view of Hermann (Figure 6) and optionally Kajitani.

Shirota '107 or Ito '368 show all of the pertinent patentable features except the introduction of air into the plenum below a tilted evaporator core along a side of the evaporator core in which the tilt direction occurs. Instead, in Sirota and Ito, the air is introduced at the side of the evaporator core in which the upper header in located.

To have reoriented the air entry in Shirota or Ito to be along the side of the evaporator core in which the tilt direction occurs would have been obvious to one of ordinary skill in considering Figure 6 of Hermann which teaches this configuration. As discussed in Hermann, the unit can be made more compact and still house a fairly large evaporator. Applicants state in their comments in Paper No. 6, page 9, lines 7-9, that in Hermann "an air-blowing direction under the heat exchange element (5) is parallel to the longitudinal direction of the tubes." The Examiner has re-read Hermann three times and is at a loss as to how applicants can make this factual assertion.

In response to this rejection, please explain how applicants can state unequivocally that the tubes are oriented as they assert. It is submitted that there is no tube direction disclosed in Hermann. Hermann simply teaches the same orientation of fan air supply direction relative to the tilted evaporator core orientation that applicants' disclose and claim. It is submitted that the tubes shown in Shirota and Ito are both oriented parallel to the tilted direction of the evaporator core as disclosed and claimed by applicants and, with regard to the Examiner's rejection, there is no reason why the downward orientation of those tubes in the direction core itself would be changed in the modification the Examiner has proposed. The Examiner only proposes changing the orientation of the fan relative to the tilted tube core in the manner taught by Figure 6 of Hermann.

If necessary, simply to reinforce the previous argument, the Examiner relies on Kajitani to teach a heat exchanger with tubes oriented parallel to the tilted core with air flow through the side of the heat exchanger in which the tilt direction of the core is evident.

Regarding claims 2 - 17, 20 and 24, the direction of the casing orientation in a vehicle is not a meaningful limitation in a claim (see claims 1 and 8) drawn to the air conditioner per se. If the combination of a vehicle and air conditioner is being claimed, please change claims 1 and 8 to clearly recite the combination. Absent such a combination claim or a "method-of-use" claim, matters of intended orientation in some unclaimed use in some unclaimed vehicle are extended no patentable weight. Notwithstanding, what the Examiner has just stated, he can see no reason why the modified apparatus of Ito/Hermann or Shirota/Hermann undergoes any metamorphosis into some new, novel and unobvious apparatus merely by shifting the orientation of the components

and/or the casing to make it conveniently fit under the dashboard of the vehicle (if a vehicle is even being claimed). In the forthcoming reply to this action, please address in detail why each of claims 2-17, 20 and 24, in so far as orientation of the air conditioning apparatus within the vehicle is being claimed, defines patentable subject matter. It appears to the Examiner that this is just routine engineering design. If some part of the unit doesn't fit (e.g. it interferes with the steering column etc.) then it is moved or reoriented (e.g. move the fan or reorient the casing) until it does fit. It is submitted that the orientations claimed in claims 2-17, 20 and 24 are no more than the orientations which happen to work in the vehicle that applicants' device is being fitted into. If it is anything more than this, please provide evidence, commensurate in scope with these claims to back-up any assertions made.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JA 10-244820, filed 3-3-1997 (before applicants' PCT JP 98/03586 filed 8-10-1998, but after applicants' JP 09-216539, filed 8-11-1997, which latter application does not appear to disclose the invention claimed here).

The Examiner's comments above are incorporated here by reference.

Any inquiry concerning this communication should be directed to John Ford at telephone number (703) 308-2636.

John K. Ford
Primary Examiner